

REMARKS

This request for reconsideration is being filed in response to the Office Action dated June 3, 2008. For the following reasons this application should be allowed and the case passed to issue.

Claims 1-3 are pending in this application. Claims 1-3 were rejected.

Claim Rejections Under 35 U. S. C. § 112

Claims 1-3 were rejected under 35 U.S.C. § 112, first paragraph, because the specification allegedly does not enable the selective absorption of oxidized sebum to the exclusion of other types of sebum. This rejection is traversed, and reconsideration and withdrawal thereof respectfully requested.

The Office Action has no basis for the above-rejection. Initially, it is noted that the claims do not require, “selectively capable of absorbing oxidized sebum **to the exclusion of other types of sebum**” (emphasis added). Nowhere in the claims or the specification is it taught that oxidized sebum is absorbed to the exclusion of other types of sebum. Therefore, the Office Action has no grounds for rejecting the claims as non-enabled because the selective absorption of oxidized sebum to the exclusion of other types of sebum is not enabled. Rather than addressing the invention as claimed, the Office Action reads limitations into the claims.

This rejection is further traversed because it appears that the analysis of lack of enablement was improper. The Office Action listed several *Wands* factors to assert that the invention was not enabled. The Office Action, however, apparently did not consider all of the factors which must be considered when making a rejection for lack of enablement. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988) lists a number of factors to be considered when determining whether an invention is enabled, including:

- A) The breadth of the claims;
- B) The nature of the invention;
- C) The state of the prior art;
- D) The level of one of ordinary skill;
- E) the level of predictability in the art;
- F) The amount of direction provided by the inventor;
- G) The existence of working examples; and
- H) The quantity of experimentation needed to make or use the invention based on the content of the disclosure.

In addition, “[t]he Examiner’s analysis must consider all the evidence related to each of these factors, and any conclusion of nonenablement must be based on the evidence as a whole.” 858 F.2d at 737, 740, 8 USPQ2d at 1407, 1407. It is clear that the office action did not (a) consider the evidence as a whole, nor (b) consider the claims as a whole when reaching the conclusion of nonenablement.

Furthermore, contrary to the Office Action, the present claims are fully enabled and supported by the specification as originally filed. The Office Action has not established a prima facie case of nonenablement. The rejection based on 35 U.S.C. § 112 is clearly erroneous and should be withdrawn.

Claim Rejections Under 35 U.S.C. § 103

Claims 1-3 were rejected under 35 U.S.C. § 103 for obviousness based upon EP 0 393 723 (EP ‘723), in view of alleged acknowledged prior art, JP 11-137336 (JP ‘336), Fujii et al. (U.S. Pat. No. 5,041,252), JP 63188628 (JP ‘628) or JP 63027411 (JP ‘411). This rejection is traversed, and reconsideration and withdrawal thereof respectfully requested. The following is comparison between the present invention as claimed and the cited prior art.

The Office Action asserted that EP ‘723 discloses papers and nonwoven fabrics carrying or incorporating calcium phosphate compounds having a particle size of 0.1 to 30 μm as fillers in an amount of 10 to 80 % by weight. The Office Action further asserted that EP ‘723 discloses

hydroxyapatite, a paper basis weight of 20 g/m² or more, and talc. The paper can be used to absorb oil-soluble substances and can be used in diapers, sanitary napkins, and pads for bedsores. The Office Action averred that Fujii et al. disclose nonwoven fabric with apatite additive and a basis weight of preferably 10 to 300 g/m² for use in a baby's napkin, sanitary napkins, and toilet paper. The Office Action maintained that JP '336 discloses a paper used to absorb oil from the skin containing talc having an average particle size of 1.2 microns. The Office Action asserted that JP '628 or JP '411 disclose that hydroxyapatite is used in cosmetic products to absorb oxidized lipids to treat acne. The Office Action concluded that the prior art suggests the claimed sebum absorbing paper because it is known to use papers containing hydroxyapatite and talc as absorbants, papers containing talc are known to be used for absorbing oil from skin and that hydroxyapatite is used in cosmetic products to absorb oxidized lipids. Therefore, one of ordinary skill in the art would have been motivated to modify the prior art with the expectation that a paper containing hydroxyapatite and talc would be suitable for absorbing oxidized sebum from the skin because hydroxyapatite powders are known to be effective in absorbing oxidized lipids from the skin.

Contrary to the Office Action, the sebum absorbing paper of the present invention is not obvious in view of EP 0 393 723 (EP '723), alleged acknowledged prior art, JP 11-137336 (JP '336), Fujii et al. (U.S. Pat. No. 5,041,252), JP 63188628 (JP '628) or JP 63027411 (JP '411). The primary reference, EP '723, is not directed to a paper used for applying to skin or for cleaning the skin, as recited in claim 1. Instead, as described in fields of application (a)-(g) on pages 9-10 of EP '723, the disclosed paper with hydroxyapatite is used for (a) deodorants, (b) filter mediums, (c) adsorbents, (d) substitute materials for biomaterials, (e) food wrapping papers, (f) articles in a bioindustry, and (g) articles in a medical treatment. Furthermore, as recited in claim 1, the claimed

paper is capable of selectively absorbing oxidized sebum (e.g., lipids excreted from sebaceous glands in the skin) from other types of sebum; however, this feature is neither taught nor suggested by EP '723.

Secondary reference of JP '336 was cited to teach a paper containing talc used to remove oil from the skin. However, JP '336 is completely silent with regard to the use of hydroxyapatite.

Tertiary reference Fujii et al. is relied on as teaching that nonwoven fabric in the form of baby's napkin, women's sanitary napkin, and toilet paper in which apatite is added to improve properties. Fujii et al., however, disclose implant materials having a good compatibility with a living organism. The reference to Fujii et al. is **remote** to sebum absorbing paper and does not suggest selectively absorbing oxidized sebum from other types of sebum, as required by claim 1.

Tertiary references, JP '628 or JP '411, were relied upon to teach that hydroxyapatite is used in a cosmetic product to absorb oxidized lipids. JP '411, entitled "Dust Preparation for Skin External Use," discloses a powdery preparation that is applied to the skin to "prevent or improve skin roughness." It is noted that JP '411 discloses a product that is not part of a paper, and JP '411 does not suggest that hydroxyapatite would be effective in selectively absorbing oxidized sebum from other types of sebum, as required by claim 1.

JP '628 is also not related to a paper product. Instead, JP '628, entitled "Drug for Skin External Use," is directed to a blend of a hydroxyapatite powder with antiphlogistics and/or keratin release agents. As described in the abstract, the product can be in the form of a shape of cream, ointment, lotion, tonic, powder. JP '628, furthermore, does not suggest that the hydroxyapatite can be used as a filler in a paper used to selectively absorb oxidized sebum from other types of sebum, as required by claim 1.

In summary, the applied references describe a non-skin related paper (i.e., EP '723), a paper to be used for cleaning the skin (JP '336), implant materials having a good compatibility with a living organism (Fujii et al.), and a pair of non-paper related products (i.e., JP '628 and JP '411).

With regard to the Office Action's prima facie obviousness assertion, it is submitted that the mere identification of various claim features in disparate references is insufficient to establish the requisite realistic motivation to support the ultimate legal conclusion of obviousness under 35 U.S.C. § 103. *Grain Processing Corp. v. American-Maize Products Co.*, 840 F.2d 902, 5 USPQ2d 1788 (Fed. Cir. 1988).

The Examiner's stated motivation to combine the cited references is that "one of ordinary skill in the art would have been motivated to modify the prior art as above with the expectation that a paper containing hydroxyapatite and talc would be suitable for absorbing oxidized sebum from the skin." This statement merely describes an expected end result taught by the present disclosure without explaining why this result would have been expected (i.e., the rationale that would have led one skilled in the art to this result).

EP '723 is not directed to a paper used for applying to skin or for cleaning the skin. Despite the discussion of many different uses for the disclosed paper, including use as a filter medium and a food wrapping paper, EP '723 is completely silent about using the disclosed paper for applying to the skin or for cleaning the skin. Although EP '723 discloses that the "functional paper shows preferably a basis weight of 20 g/m² or more," which falls within the claimed 5 to 25 g/m², the specific examples disclosed by EP '723 are all 48 g/m² or greater.¹ This weight of paper in the examples found in EP '723, although presumably appropriate for the heavier duty applications

¹ 85 g/m² in Example 4; 99 g/m² in Example 6; 93 g/m² in Example 9, 101 g/m² in Example 10; 103 g/m² in Example 11; 105 g/m² in Example 12, 98 g/m² in Example 13; and 48 g/m² in Example 14.

discussed in EP '723, would not have been recognized as appropriate for use on the skin for absorbing sebum, since sebum absorbing papers conventionally are thin and soft.

Based upon the absence of a teaching in EP '723 that the disclosed paper can be used for skin cleansing and the paper basis weights disclosed in the examples of EP '723, which are too heavy to be previously considered as sebum absorbing papers, one skilled in the art would not have recognized EP '723 as being directed to a paper used for applying to the skin or for cleaning the skin, as recited in claim 1. Thus, one skilled in the art of skin cleansing with paper would not look to a reference (i.e., EP '723) that teaches a product that is related neither to skin cleansing nor sebum removal.

References JP '628 and JP '411, cited to teach that hydroxyapatite absorbs oxidized lipids, are completely silent about using hydroxyapatite as a filler in a sebum absorbing paper. Instead, both of these references disclose hydroxyapatite in the form of a powder that is directly applied to the skin or is applied via another delivery system, such with a cream, ointment, or lotion. These references, although disclosing many different systems in which the hydroxyapatite can be delivered to the skin, are conspicuously silent with regard to the use of hydroxyapatite as a filler for a sebum absorbing paper. The Examiner, however, has failed to explain why one having ordinary skill in the art would believe, with a reasonable expectation of success, that a product taught as being directly applied to the skin or used in other deliver systems *with the notable exception of paper*, could be applied to the skin with paper.

Notwithstanding that the Examiner has failed to supply a realistic motivation to combine the applied prior art to arrive at the claimed invention, it is submitted that even if the prior art were combined in the manner suggested by the Examiner, the claimed invention would not result. Claim 1 recites that the paper is selectively capable of absorbing oxidized sebum from other types of

sebum. The problem this limitation is intended to solve (i.e., minimizing the absorption of other types of sebum, such as new sebum) has not been recognized by the prior art, and the applied prior art fails to explicitly teach selectively absorbing oxidized sebum.

Furthermore, even if one skilled in the art were to add hydroxyapatite to a sebum absorbing paper with knowledge of the teachings of the applied prior art, the record does not establish that such a paper would selectively absorb oxidized sebum from other types of sebum. The applied prior art discloses many different types of fillers for the paper (see, for example, page 9, lines 9-10 of EP '723) that can be combined with hydroxyapatite, and these fillers do not necessarily selectively absorb oxidized sebum from other types of sebum. There is no reason to conclude that the Examiner's proposed sebum absorbing paper, although including hydroxyapatite, would selectively absorb oxidized sebum from other types of sebum.

In order to establish the requisite realistic motivation, the Examiner must make clear and particular **factual findings** as to a **specific understanding or specific technological principle** and then, based upon such **facts**, explain **why** one having ordinary skill in the art would have been realistically motivated to modify a **specific prior art**, in this case presumably the papers and nonwoven fabrics of EP '723, to arrive at the claimed invention. *In re Lee*, 237 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002); *Ecolochem Inc. v. Southern California Edison, Co.* 227 F.3d 1361, 56 USPQ2d 1065 (Fed. Cir. 2000); *In re Kotzab*, 217 F.3d 1365, 55 USPQ 1313 (Fed. Cir. 2000); *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999); *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998). This burden has **not** been discharged. As pointed out above, the Examiner has identified features in the applied references and then announced the obviousness conclusion without complying with judicial requirements requiring clear and particular factual findings and reasons based upon such findings. Instead what the Examiner has

done is pointed to isolated features and then announced the obviousness conclusion. This approach is **legally erroneous**. *In re Dembiczak, supra; Grain Processing Corp. v. American-Maize Products Co.*, 840 F.2d 902, 5 USPQ2d 1788 (Fed. Cir. 1988).

Applicants would stress that none of the applied prior art expresses any recognition for the problem of selectively absorbing oxidized sebum from other types of sebum. This failure of the applied prior art underscores the lack of motivation. The Office Action does not gainsay that the applied references are mute as to selectively absorbing oxidized sebum from other types of sebum. Nevertheless, the Office Action assumes that the claimed invention would have been obvious because the Examiner has identified perceived features of the claimed invention in these disparate references. There is no automatic motivation, particularly in the present situation where the references are conspicuously silent as to the problem addressed and solved by the claimed invention.

Based upon the foregoing it should be apparent that a prima facie basis to deny patentability to the claimed invention has not been established for lack of the requisite factual basis and want of the requisite realistic motivation. Moreover, there is a potent indicium of non-obviousness which the Office Action failed to consider.

The Office Action has failed to establish a prima facie basis to deny patentability to the claimed invention under 35 U.S.C. § 103 for lack of the requisite factual basis and want of the requisite realistic motivation. Moreover, upon giving due consideration to the problem of selectively absorbing oxidized sebum from other types of sebum which is addressed and solved by the claimed invention, and the failure of the applied prior art to appreciate that problem, the conclusion appears inescapable that one having ordinary skill in the art would **not** have found the

claimed subject matter as a whole, obviousness within the meaning of 35 U.S.C. § 103. *Jones v. Hardy*, 727 F.2d 1524, 220 USPQ 1021 (Fed. Cir. 1984).

While the Office Action cited a number of passages from *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396, 1397 (U.S. 2007), there is no explanation of how these passages pertain to the present invention. It is not sufficient to merely cite *KSR* to establish obviousness. In fact, the Court was quite clear that, “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness,” *KSR*, slip op. at 14 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). Further, the Court recognized, “it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does,” *KSR*, slip op. at 15. Furthermore, in *KSR* the prior art references were directed to automobile pedals. On the other hand, the references applied in the present Office Action are directed to different arts; non-skin related paper (i.e., EP '723), a paper to be used for cleaning the skin (JP '336), implant materials having a good compatibility with a living organism (Fujii et al.), and a pair of non-paper related products (i.e., JP '628 and JP '411), as explained above. Thus, the facts in *KSR* are very different from the instant application.

In view of the above remarks, Applicants submit that this application should be allowed and the case passed to issue. If there are any questions regarding this Amendment or the application in general, a telephone call to the undersigned would be appreciated to expedite the prosecution of the application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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